APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/998,033	12/24/1997	SURESH JEYACHANDRAN	35.C12462	2065

5514   7590   10/02/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY   10112

EXAMINER
KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Application No.	Applicant(s)
08/998,033	Jeyachandran et al.
Examiner	**Art Unit**
Victor R. Kostak	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*,935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-174_ is/are pending in the applica

　　4a) Of the above, claim(s) _____ is/are withdrawn from considerა

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-26 and 28-174_ is/are rejected.

7) ☒ Claim(s) _27_ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b) ☒ Some* c) ☐None of:

　　　1. ☒ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

　　a)☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). ___6___

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

1. Foreign Priority document 8-348308 (Dec. 26, 1996) has not been received.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Note MPEP 606.01.

3. Claim 29 objected to because "devices" should be singular. Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32, 40, 88-104, 106, 154-170 and 174 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 introduces "another device" which accordingly requires a first device, but a first device has not been recited. "Another device" therefore lacks definite antecedence.

The phrase "locally own," recited in claims 40 and 106, is not understood, which therefore makes the claim scope indefinite.

Claims 88, 154 and 174 all refer to "said device" but only *another* device" was first mentioned.

Claims 89, 92, 155 and 158 are further indefinite because claims 89 and 155 recite

"another device", although respective base claims 88 and 154 already introduce "another device".

It is not clear if they are the same device.

In claims 90 and 156, "said instruction information" lacks antecedent basis.

In claims 100 and 101, "said designation means" also lacks antecedence.

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use
> or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> or   (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined was

not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the

AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13, 15-47, 49-60, 62-89, 91-99, 102, 105-114, 116-126, 128-155, 157-168 and

171-174 rejected under 35 U.S.C. 102(e) as being anticipated by Weiser et al.

Weiser (Fig. 1) discloses a bi-directional communication system where a device can remotely control another device through a network, the transmission procedures outlined in Figs. 1, 4-9. Table 1 lists examples of actions prompted by a messaging environment 20 (i.e. any type of networking arrangement) connected to a PC 24 from which e-mails can be sent through network 20, to which any one or plural devices are sent instructions for performing various operations, such as a printout of 5 files. Each device includes a processing module 40 which includes a microprocessor chip which carries out programming of various software (col. 7 lines 46-50), by which the network invokes the specific user-requested tasks. Steps included to carry out the remote operation includes receiving information regarding a device to be controlled (e.g. device ID, various operating functions), validation of operating procedures (e.g. col. 6 line 63+), and transmission control carried out by the network, thereby meeting claims 1, 3, 11, 20, 21, 39, 105 and 171.

As for claim 2, user requests are naturally initiated (e.g. col. 10 line 66).

As for claims 4, 5, 22 and 23, module 40 stores various possible applications per device (Fig. 2), and network server 32 also stores a directory of services available. Each selectable receiver device has a unique address (or ID) to which the requested tasks are validated and routed, the operations to be carried out of course being consistent with the type of device selected (e.g. printer, copier).

Regarding claim 6, information regarding the device to be controlled is received from that device (note again table 1).

As for claims 7 and 32, information regarding the device to be controlled is received from another device, such as the router itself, or the user's PC (e.g. col. 3 lines 32-36; col. 4 line 56 - col. 5 line 4).

As for claims 33-38, data validation and operation storage has been addressed above, and the results of the operation are sent to the network router (communication means) and then to the user to inform him of the completed requested tasks (col. 11 discusses results of tasks including transmission of completion codes).

As for claims 12 and 13, Weiser also provides plural routing options in pointing out the multitude of network options (col. 4 lines 39-44), from which a communication route is selected.

Considering claim 15, Weiser discloses group routing (function 26 in Table 1).

As for claims 16 and 28-31, module 40 of each device provides storage of a history of functions to be carried out. The router also includes storage for the task list, and the device selected to perform those tasks accordingly carries them out as commanded.

Regarding claims 17, 18, 88, 98 154, 164 and 174, Weiser controls a copier or printer, for example, using a data commands from a PC, which go through a routing network (i.e. an intermediate device) as discussed above.

As for claim 19, the status of the selected device is monitored as well (e.g. "Waiting" "complete"; cols. 13 and 14).

As for claims 24-26, the IDS and addresses of the individual devices are also included (for the requisite purpose of knowing which specifically selected device is to perform the tasks in question), as well as the user's ID (e.g. col. 12 line 7).

Concerning claims 40 and 106 (as best understood, noting the indefiniteness of these two claims), devices local to the user can also be selected to carry out various processes, and wherein the status, user instruction, and contents of the specific tasks are naturally involved to carry out the task(s) requested by the user.

As for claims 41-43, 50, 53, 54, 107-109, 116, 119, 120 and 172, the user can access multiple devices including external devices (e.g. a remote printers by group routing), which process includes acquiring a transmission request response from the external device (e.g. col. 10 line 66 - col. 11 lines 23).

Regarding claims 44, 66, 110, 132, 134 and 173, each device includes storage capabilities, as is typical, and as noted previously.

As for claims 45 and 111, the external device is directed to carry out instructions upon user request (as was also, mentioned previously, module 40 includes software corresponding to the tasks germane to the device).

As for claims 46, 47, 52, 112, 113 and 118, the external device is prompted by a message sent by the user (i.e. through an e-mail), to which the device responds.

As for claims 49 and 115, the external device can send a response though e-mail back to the user indicating, for example, that an error has occurred, thereby instructing or providing alternatives to the user to take other action (col. 12 line 34+).

Considering claims 51 and 117, the processing means can be a printer which outputs printed documents.

As for claims 55 and 121, the communication system includes determining if the acquisition (request) should be considered is done by verification/validity checking (e.g. Fig. 6).

As for claims 56 and 122, the user can request output (e.g. print 5 copies: an example given in Table 1) to which a determination is made to this input request for the output.

The input request can be given in a natural language by using e-mail, thereby meeting claims 57, 65, 123 and 131.

As for claims 58 and 124, the status of the device in question is also identified (e.g. "waiting") in the communication process, as discussed above.

As for claims 59, 60, 125 and 126, the external device can be a copier or printer, and display of data can be done (col. 11 line 4; table spanning cols. 11 and 12).

Regarding claims 62, 63, 128 and 129, Weiser also considers transmission formatting and conversion if necessary in order to accommodate a user (col. 50+). Data presentation format is also identified and can be modified (list in col. 11).

As for claims 64 and 130, any data obtained by user request can be in list form (since files and documents are transmitted).

As for claims 67 and 133, data is input to the external device for processing by the external device.

As for claims 68 and 134, the network server controls transmissions upon user request to a selected external receiver device to which the requested tasks are validated and routed, using the input from the user.

Considering claims 69, 91 and 92, 135, 157 and 158, any one or plural external devices can be designated.

As for claims 71 and 137, group routing can be done, as discussed previously, which means that data is transmitted to plural destinations at the same time (i.e. in parallel).

Regarding claims 72, 73, 138 and 139, a verification/validity check is determined in order to authorize a specific user to use the communication system, which is also discussed above.

As for claims 74 and 140, the status of a device is identified and an appropriate response is accordingly made, as mentioned previously.

As for claims 75 and 141, group routing can be done, as discussed previously, which means that data is transmitted to plural destinations at the same time (i.e. in parallel).

As for claims 76, 78, 82, 142, 144 and 148, instructions are sent to the external device to carry out a process thereby, and a printer can be subsequently instructed in response to a copier or scanner condition (col. 10 line 66 - col. 11 line 7).

Considering claims 77 and 143, Weiser also permits setup steps involving printer parameters (e.g. how many copies: Table 1).

As for claims 79 and 145, the external device searches for files, for example (col. 13 lines 20-24).

Regarding claims 80, 81, 146 and 147, image data to be printed by a printer is taken or transferred from a scanner or copier (col. 10 line 66 - col. 11 line 7). Alternatively, e-mails can be retransmitted from one user to another at will.

As for claims 83-85 and 149-151, the external devices can print, display, and they all store, as pointed out earlier.

Concerning claims 86, 87, 152 and 153, the input means can be a reader (e.g. fax machine), or a scanner (i.e. image forming means).

As for claims 89 and 155, information regarding the device to be controlled is received from another device, such as the router itself, or the user's PC (e.g. col. 3 lines 32-36; col. 4 line 56 - col. 5 line 4). Also, image data to be printed by a printer is taken or transferred from a scanner or copier (col. 10 line 66 - col. 11 line 7). Alternatively, e-mails can be retransmitted from one user to another at will.

As for claims 93, 95, 96, 159, 161 and 162, Weiser includes validation checks, for example, if files cannot be obtained, and another device prints out data (col. 10 line 66 - col. 11 line 7).

As for claims 94 and 160, all devices have a module 40 which, for one, can store data, and the system validates the stored data upon attempted retrieval by the user.

As for claims 97 and 163, the routers can get a message from any user in e-mail form, indicating what procedure a selected device is desired to be carried out.

Regarding claims 99 and 165, the operating information is instruction data to be performed by a selected device (i.e. "print 5 copies").

Considering claims 102 and 169, each device has its unique ID, and each device has its own functions to perform (e.g. scan, print, copy), which the system inherently detects in order to be able to carry out those functions, which are activated upon command by a user.

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14, 103 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser et al.

It would have been clearly obvious to one of ordinary skill in the art to re-route data if a current channel is occupied, for the clear purpose of transmitting the data as promptly as possible, such being a typical priority in data communication.

It would also have been clearly obvious to provide continuous two-way communication between the user and device for the clear purpose of keeping the user informed on the progress of

the operation of the device selected to carry out that operation, and to verify continuance of the progress, if it is determined that the operation should be cancelled or continued.

7.   Claims 39, 46, 48, 105, 112 and 114 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryu et al.

The system of Ryu (Figs. 1, 2) involves a determining a process (i.e. storing data) and carrying out the process, wherein requesting available storage space from a node through a network is done by messaging (note particularly Fig. 6).

8.   Claims 61 and 127 are rejected under 35 U.S.C. 102(e) as being anticipated by Funahashi et al.

Funahashi includes communication means involving a central control unit M1, terminals M2, and a transmission line connecting them. External device 5 includes processing of A/V data, which data is acquired from the external device and presented as voice data at output 49, all under the control of CPU 41.

9.   Claims 88, 90, 100, 101, 154, 156, 166 and 167, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lawler et al.

The system of Lawler (noting particularly Figs. 1 and 2) performs a recording function (claimed process) based on an operation (request to headend to download programming, in this case to be recorded), based on information input to recorder 23. The results of the recording are

output to TV 20 (the claimed other device) under the control of whatever command to display/playback the recorded programming, based on the initial operation (i.e. recording request), thereby meeting claims 88 and 154.

As for claims 90 and 156, even when the recorder is not communicated to, the TV can be function according to programming downloaded from the headend. When communication is enabled to the recorder, instructions for recording are naturally applied thereto.

As for claims 100 and 166, Lawler shows multiple receiving ends in parallel, all of which can be controlled at the same time when a particular program is made available.

As for claims 101 and 167, each receiving station has a unique address which can be identified on an individual basis.

10.   Claims 1, 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al.

The system of Hanson (noting particularly Figs. 1-3 and 12) arranges a reception means (scanner 12) which receives information regarding a device to be controlled (printer referred to in Fig. 3); validating means (inherent bar code validator); and transmission control means (link from scanner to multi-dock 23 at city station 14), the operating command being a print-out function.

As for claims 8-10, the shape information is the bar code, and the specific portion of the device is the printing mechanism (which effectively is the whole device, as it is the only action carried out).

11.   Claim 27 appears allowable over the prior art

12.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Victor R. Kostak whose telephone number is (703)-305-4374. The

examiner can normally be reached on Monday through Friday from 6:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Andrew I. Faile, can be reached on (703) 305-4380. The fax phone number for the organization

where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Technology Center 2600 Customer Service Office whose telephone

(703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
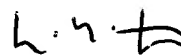
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (For either formal or informal communications intended

for entry. For informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive, Arlington. VA., Sixth Floor (Receptionist).

Victor R. Kostak

Primary Examiner

VRK

9/27/02